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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,607	10/31/2003	Alexander Paul Carobus	Google-60 (GP-064-08-US)	9942
26479	7590	07/25/2006	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			PARDO, THUY N	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/699,607	Applicant(s) CAROBUS ET AL.	
	Examiner Thuy N. Pardo	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☒ Claim(s) 28-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Amendment filed on April 19, 2006 has been reviewed. Claims 1-7, 15-21 have been amended, and claims 22-36 have been added.
2. Claims 1-36 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogura et al. (Hereinafter "Ogura") US Patent No. 2002/0147646.

As to claim 15, Ogura teaches the invention substantially as claimed, the method comprising:

a) accepting, from the client device, a document identifier [Parts IDs, fig. 47; fig. 63] in an ad request to a content-relevant ad server [advertisement statement is displayed at the portable telephone set by the user's Email receiving operation, ab; 0082-0084];

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b) using content-relevance information associated with the document identifier and ad information to determine a set of one or more ads [reads out the contents of the link stored in the content DB, 0167-0168];

c) generating an image including the one or more ads of the determined set [an advertisement that contains image information, 0011];

d) forwarding the generated image and a session identifier to the client device [ab; fig. 47; 0153]; and

e) accepting, from the client device, the session identifier and position information [fig. 49; 53-54; 0011].

As to claim 1, Ogura teaches the invention substantially as claimed. Ogura further teaches detecting a user action with respect to the rendered image and in response to the detection of the user action with respect to the rendered image, sending the session identifier and position information to the content-relevant ad server [document request ID, fig. 44; ab; fig. 54-55].

As to claim 2, Ogura teaches the invention substantially as claimed. Ogura further teaches that the document includes image map information including image source information, and wherein the image source information includes the document identifier [Advertisement ID, fig. 27].

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As to claim 3, Ogura teaches the invention substantially as claimed. Ogura further teaches that the document includes image map information including image source information, and wherein the image source information is a path including the unique identifier [fig. 37].

As to claim 4, Ogura teaches the invention substantially as claimed. Ogura further teaches the path further includes a URL of the content-relevant ad server [Web access, 0170; fig. 43-45].

As to claim 5, Ogura teaches the invention substantially as claimed. Ogura further teaches updating, with the content-relevant ad server, ad information using the sent session identifier and position information [fig. 22-23, 24-26].

As to claim 7, Ogura teaches the invention substantially as claimed. Ogura further teaches that the ad information updated includes billing information [fig. 16, 18, 22, 32].

As to claims 8-14 and 16-21, all limitations of these claims have been addressed in the analysis of claim 1-7 and 15 above, and these claims are rejected on that basis.

As to claims 22-24, Ogura teaches the invention substantially as claimed. Ogura further teaches that the document is an e-mail [see the abstract; fig. 65].

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As to claims 25-27, Ogura teaches the invention substantially as claimed. Ogura further teaches that the set of one or more ads are determined to be relevant to the content of the document [0192; 0292].

Allowable Subject Matter

Claims 28-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 28-30, the limitations that the image includes at least two ads wherein the user action is a user selection of one of the at least two ads included within image, and wherein the position information is a position of a cursor within the image at the time of a user selection, taken together with all limitations of claims 1, 8 and 15 are allowable over the prior art of record.

As to claims 31 and 34, the limitations that the image includes at least two ads wherein the user action is a user selection within the image and the use of the sent session identifier and position information to determine a particular ad that was selected by the user, taken together with all limitations of claims 1, 8 and 15 are allowable over the prior art of record.

Claims 32, 33, 35 and 36 further limiting to claims 31 and 36 are also objected to.

Response to Arguments

4. In response to applicant's arguments, the limitation that the ads are target to users based on an analysis of the relevance to content of an email has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Examiner believes that the feature of analyzing the relevance to content of an email is not in the body of independent claims 1, 8 and 15. Furthermore, Examiner also believes Ogura teaches this feature. Ogura provides the feature of determining whether the user is an owner, and then apply a discount or a ½ discount based on the analysis [see fig. 61-63].

Applicant argues that Ogura does not teach using content-relevance information associated with the document identifier to determine a set of one or more ads.

As to this point, examiner respectfully disagrees. Ogura teaches displaying advertisement statement by the user's email receiving operation [see the abstract and the entire disclosure; fig. 43-44, 65]. The server determines a user who transmits an advertisement such as direct email and the contents of advertisements [0164] based on the user names, passwords and Device ID [see fig. 13-16]. Furthermore, the server also provides a link to read out the contents of the link stored in the contents database of the server via Internet [see 0168; 0176; 0177].

Applicant argues that Ogura does not teach the feature of position information.

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Examiner respectfully disagrees. Examiner believes that Ogura teaches this feature. Ogura teaches that ads are posted based on the priority of sale products applied discount rates to specific customers [see fig. 33]. For examples. “20% off for Suzuki”, or “10% off if you introduce somebody” [see 0288; 0290; 0293].

5. Applicant's arguments filed on April 19, 2006 have been fully considered but they are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, the examiner's supervisor, Jeffrey Gaffin, can be reached at 571-272-4146.

The fax phone number for the organization where this application or proceeding is assigned as follows:

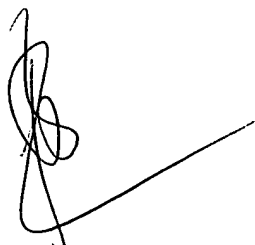
571-273-8300 (Official Communication)

and/or:

571-273-4082 (*Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions).*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 21, 2006



THUY N. PARDO
PRIMARY EXAMINER